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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/182,833	10/29/1998	MICHAEL D. STANFORD	PIC-007	2435

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EXAMINER

HAROLD, JEFFEREY F

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 03/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

66

Office Action Summary

Application No.

09/182,833

Applicant(s)

STANFORD ET AL.

Examiner

Jefferey F. Harold

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Objections

1. Applicant is advised that should claim 10 be found allowable, claim 11 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Regarding **claim 1**, the phrase "such as" in line 25 renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 7 recites the limitation "said dialer" in line 1 of claim 7. There is insufficient antecedent basis for this limitation in the claim. The examiner recommends that "said dialer" be changed to --said dialer program--. For the purpose of the following rejection the examiner has assumed that the above stated suggestion will be accepted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. ***Claims 1-7, 10-16 and 18*** are rejected under 35 U.S.C. 102(e) as being anticipated by Langlois et al. (United States Patent 6,018,5710), hereinafter referenced as Langlois.

Regarding **claim 1**, Langlois discloses a system for interactive control of a computer and telephone, which reads on claimed apparatus. In addition, Langlois discloses a personal computer (7) controlled by Windows 95®, which reads on claimed “operating system program”, and an inherent plurality of driver programs for peripheral devices and TAPI compliant software application for communicating, which reads on claimed “one or more application programs”, Windows 95® includes application (17) and TAPI layer (31), which is a Microsoft device independent communication library, which reads on claimed “telephone function library of programs”, that control the

computer (7) to implement convention telephone functions, Windows 95® controlling computer (7) to implement a TAPI, comprising hang-up and hold functions, which reads on claimed "plurality of function calls", each of which may be invoked to implement a known telephony function by executing one or more of the programs in the TAPI layer (31), as disclosed at column 4, line 60 through column 7, line 39 and exhibited in figures 1-5;

a telephone set (1), which reads on claimed TAPI compliant telephony peripheral device", inherently capable of digital communication with the computer (7) and coupled to the computer by serial link (9), which reads on claimed "data path", and structured for connection to a telephone line (5) from a telephone switching system (3), which reads on claimed "telephone service provider", the telephone set (1) structured to be capable of carrying out telephone function commands issued by one or more programs in execution from the application (17) and TAPI layer (31) so as to control the computer (7) to implement a conventional telephone function for each function call in the telephone set (1), as disclosed at column 4, line 60 through column 6, line 4 and exhibited in figures 1-2;

a keyboard (12) and a mouse pointer (10) coupled to the computer (7) for providing user inputs, as disclosed at column 4, line 60 through column 5, line 7 and exhibited in figure 1;

a monitor coupled to the computer (7), as disclosed at column 4, line 60 through column 5, line 7 and exhibited in figure 1;

and wherein Windows 95® includes application (17), which reads on claimed "TAPI compliant dialer program", which is coupled to telephone set (1) through the computer (7) and which is capable of controlling the telephone set (1) to provide selected forms of call control functionality such as dial which may be invoked through context sensitive menus displayed on the monitor (8), as disclosed at column 5, line 22 through column 7, line 38 and exhibited in figures 1-4.

Regarding **claims 2-4**, Langlois discloses everything claimed as applied above (see claim 1), in addition, Langlois discloses wherein the application (17) controls the computer to display a main window display (57), which reads on claimed "dialer icon", on the monitor (8) and the title bar appears in the tray icon (109) of the Windows 95® task bar as to be always visible regardless of which program is currently controlling execution of the computer (7), as disclosed at column 6, line 54 through column 10, line 2 and exhibited in figure 3.

Regarding **claims 5 and 6**, Langlois discloses everything claimed as applied above (see claim 1), in addition, Langlois discloses wherein application (17) controls computer (7) to control monitor (8) to display control bar (79) which reads on claimed "drop down menu" when a mouse pointer (10) passes over, which reads on claimed "click", the control bar on the main window display (17) is detected; the control bar (79) may also be opened using a keyboard sequence (Alt + m), which reads on claimed "predetermined combination of several keys on the keyboard peripheral simultaneously", the buttons (81), which reads on claimed "menu options", are context sensitive so as to provide functionality derived from all parts of the software application

(17), but only function options which are appropriate to the state of the telephone call, as disclosed at column 6, line 54 through column 7, line 38 and exhibited in figure 4.

Regarding **claim 7**, Langlois discloses everything claimed as applied above (see claim 4), in addition, Langlois discloses wherein the application program (17) controls the computer (7) to store names and telephone numbers in a phone book file stored in the inherent memory of the computer (7), as disclosed at column 16, lines 20-49 and exhibited in figure 22, and to control the monitor (8) to display menu options that depend upon whether the user has any text or numbers selected in a window of the current application program, as disclosed at column 14, line 14 through column 15, line 18 and exhibited in figures 15-20.

Regarding **claim 8**, Langlois discloses everything claimed, as applied above, (see claim 7), in addition claim 8 is interpreted and thus rejected for the reasons set forth above in the rejection of claim 7.

Regarding **claims 10 and 11**, Langlois discloses everything claimed as applied above (see claim 1), in addition, Langlois discloses wherein the application (17) controls the computer (7) to control the monitor (8) to display all available telephone function options in a Phone menu (67) when a mouse pointer (10) clicks on the main window display (57) as disclosed at column 12, line 44 through column 15, line 18; and exhibited in figure 11.

Regarding **claim 12**, Langlois discloses everything claimed as applied above (see claim 1), in addition, claim 12 is interpreted and thus rejected for the reasons set forth above in the rejection of claims 2-4 and 10-11 above.

Regarding **claim 13**, it is interpreted and thus rejected for the reasons set forth above in the rejection of claims 1-4 and 10-11 above.

Regarding **claim 14**, Langlois discloses an application (17), which reads on claimed "process", for controlling a computer (7) coupled to telephone set (1) to implement telephony functions, wherein when another program is active and with application (17) active and displayed in the tool tray the process of clicking on the application (17) adds the full window display (57) and its functions to the display area of the monitor (7), which reads on claimed "adding telephone functions to the active program", wherein the telephony functions can be carried out by a user by involving selections from a Phone menu (67), as disclosed at column 7, line 39 through column 10, line 2 and exhibited in figures 3-9.

Regarding **claims 15 and 18**, it is interpreted and thus rejected for the reasons set forth above in the rejection of claims 1-4 and 14.

Regarding **claim 16**, Langlois discloses everything claimed as applied above (see claim 15), in addition claim 16 is interpreted and thus rejected for the reasons set forth above in the rejection of claims 1-7 and 14.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 9 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Langlois in view of well know prior art (MPEP 2144.03).

Regarding **claim 9**, Langlois discloses everything claimed, as applied above, (see claim 8), however, Langlois fails to disclose a web browser program and wherein the dialer program launchers the web browser when the user selects text which is a URL. However, the examiner takes official notice of the fact that it was well know in the art to provide a web browser program and wherein the dialer program launchers the web browser when the user selects text which is a URL.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Langlois by specifically providing a web browser program and wherein the dialer program launchers the web browser when the user selects text which is a URL, for the purpose of retrieving information from regarding an individual or company from their web site.

Regarding **claim 17**, Langlois discloses everything claimed, as applied above, in the rejection of claims 1 and 14, however, Langlois fails to disclose telephone functions comprising conference and transfer. However, the examiner takes official notice of the fact that it was well know in the art to provide telephone functions comprising conference and transfer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Langlois by specifically providing telephone functions comprising conference and transfer, for the purpose of processing incoming telephone calls.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. ***Claim 1*** is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,240,168.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are both drawn to the inventive concept of having a computer controlled by an application program to implement telephone functions associated with a coupled TAPI device.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jefferey F. Harold whose telephone number is (703) 306-5836. The examiner can normally be reached on Monday-Friday 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



JFH
March 4, 2002



FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600